

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCOIS - XAVIER NUTTALL

Appeal No. 2005-0788
Application 09/757, 951

ON BRIEF

Before JERRY SMITH, SAADAT and MacDONALD, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 9-13, 17-21, 24-30 and 34-37. Claims 14-16, 22, 23, 31-33, 38 and 39 have been indicated to contain allowable subject matter by the examiner. Claims 40-43 stand withdrawn from consideration as being directed to a nonelected invention.

The disclosed invention pertains to a method or reconciling node for managing access to a digital work.

Representative claim 9 is reproduced as follows:

9. A method for managing access to a digital work, the method for execution by a reconciling node, the method comprising:

receiving at the reconciling node via a network a first report, the first report being provided in response to a transaction that provided the digital work from a content providing node to a content requesting node, the first report comprising a transaction identifier, the transaction conducted in response to a request originated by the content requesting node;

receiving at the reconciling node via the network a second report that originated from a content managing node in response to supplying by the content managing node information to validate the request, the second report comprising a value and a payee identifier;

comparing at the reconciling node the value and the transaction identifier; and

transmitting from the reconciling node onto the network a message enabling a credit to an account corresponding to the payee identifier, transmitting being in response to comparing.

The examiner relies on the following reference:

Ginter et al. (Ginter) 5,910,987 June 8, 1999

Claims 9-13, 17-21, 24-30 and 34-37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Ginter.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon does not support the examiner's rejection of the claims on appeal. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 4]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ

1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 9 as representative of all the claims on appeal.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he finds the claimed invention to be fully met by the disclosure of Ginter [final rejection, pages 3-5; incorporated into answer at page 3]. Appellant argues that the rights distributor 106 of Ginter does not meet several recitations of each of the independent claims. Specifically, appellant points out in some detail why Ginter fails to meet all the recitations of the two receiving steps and the comparing step of the claimed invention [brief, pages 4-13]. The examiner responds by noting several teachings of Ginter [answer, pages 3-5]. Appellant responds by asserting that Ginter

fails to support the supposed findings of the examiner [reply brief].

We will not sustain the examiner's rejection of the claims for essentially the reasons argued by appellant in the briefs. We agree with appellant that the examiner has failed to establish a prima facie case of anticipation. The examiner's reference to brief portions of Ginter fails to explain how the examiner has found Ginter to fully meet the claimed invention. Independent claim 9 recites a reconciling node, a content providing node, a content requesting node and a content managing node. Claim 9 also recites a communication of first and second specific reports between these nodes. We fail to see how the specific communications recited in the claimed invention are fully met by Ginter, and the brief citations to Ginter provided by the examiner fail to explain how Ginter satisfies the very specific recitations of the claimed invention. The examiner should have identified what corresponds to each of the claimed nodes in Ginter and what corresponds to the first and second reports, the request and the message enabling a credit. The examiner should not have assumed that we would be able to guess exactly how he was reading the claimed invention on the disclosure of Ginter.

In summary, we have not sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 9-13, 17-21, 24-30 and 34-37 is reversed.

REVERSED

Jerry Smith

JERRY SMITH)
Administrative Patent Judge)

Mahshid D. Saadat)

MAHSHID D. SAADAT)
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